

**REMARKS/ARGUMENTS**

In view of the amendments and remarks herein, favorable reconsideration and allowance of this application is respectfully requested. By this Amendment, claims 1, 5, 7, 12, 13, 22, 24, 25, 51-53 are amended. Thus, claims 1, 2-27, and 51-77 are pending, although claims 3, 9, 10, 16, 18-21, 23, 27, 55, 61, and 63-77 are pending and withdrawn.

**Restriction Requirement**

Applicant appreciates the Examiner's indication that the claims are not obvious variants of each other. However, in addition to the remarks laid out in the response of May 21, 2009, this Restriction Requirement is respectfully traversed for at least the following reasons.

In response to Applicant's concerns as to why this Restriction Requirement was issued some eight (8) years from the filing date of the application and after five (5) separate Office Actions, this Office Action notes that MPEP 811 permits Restriction Requirements to be made after the first Office Action. While Restriction Requirements after the first Office Action are allowed, MPEP 811 also states that, "the examiner should make a proper requirement as early as possible in the prosecution." Applicant is unclear as to how this current restriction requirement was made "as early as possible in the prosecution" of the instant application. The intervening time period between the first Office Action, two subsequent RCEs, and this current Office Action would seem to not to fall in a time period "as early as possible in the prosecution" of the application.

Additionally, the Office Action states that, "[f]our and half years have passed since the last Office Action in 2004. Over the past four and half years, a very large volume of art has become available as potential prior art." Applicant is uncertain how a "very large volume" of art becoming available in the last four years could affect the merits of the current application, which

was filed on June 6, 2001. Applicant notes that a condition precedent for prior art is that it must be prior to at least the filing date of the application in question. Thus, while Applicant does not doubt that a very large volume of art has become available in the preceding four years, it is hard to see how such art could be prior art to the instant application.

Applicant acknowledges that the Examiner of record was not a participant in the prior prosecution. However, it is unclear how such a factor would affect any potential restriction requirement. Further, Applicant notes that Applicant's representatives also were not participants in the prior prosecution.

Thus, for the at least the foregoing reasons, Applicant respectfully submits that all of the claims should be examined together, as this Office Action still has not established that a "serious burden" would be imposed if the claims were examined together.

**Claim Rejections – 35 U.S.C. § 112**

Claim 52 stands rejected under 35 U.S.C. § 112, second paragraph as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter that the Applicant regards as the invention. Without acquiescing to the propriety of this rejection, Applicant has amended claim 52. Withdrawal of this rejection is respectfully requested.

**Claim Rejections – 35 U.S.C. § 101**

Claims 1, 2, 4-8, 11, 13-15, 22, 24, 51-54, 56-60, and 62 stand rejected under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter. Without acquiescing to the propriety of this rejection, claims 1 and 51 have been amended so that the gaming method is tied to a particular machine (e.g., a gaming controller, which is in turn tied to a gaming peripheral). These claims do not recite mental processes. For example, calculating a game qualifying event

with a gaming prize controller is not a mental process. In view of the above, reconsideration and withdrawal of this rejection is respectfully requested.

**Claim Rejections – 35 U.S.C. § 102**

Claims 1, 2, 11, 13-15, 17, 22, 24, 51-52, 54, and 62 stand rejected under 35 U.S.C. § 102 as allegedly being anticipated by Jones (U.S. Patent No. 5,364,104). This rejection is respectfully traversed for at least the following reasons.

Applicant's claim 1 recites, *inter alia*, determining "odds of winning a primary wagering game; odds of obtaining a bonus game qualifying event in the primary wagering game; odds of winning the plurality of bonus prizes based at least in part on the odds of winning the primary wagering game and the odds of obtaining the bonus game qualifying event." Claim 51 recites similar features. It is axiomatic that for a claim to be rejected as being anticipated, a single reference must identically disclose each and every element of that claim in as much detail as recited in the claim. The above recited features of claim 1 are not identically disclosed in Jones. Thus, Jones fails to anticipate claim 1 and 51 (and their respective dependents). Therefore, Applicant respectfully request withdrawal of this rejection.

Jones describes utilizing progressive jackpots in combination with various card games. The functionality in Jones, as admitted in column 1 thereof, is no more than that found in an ordinary video poker machine. For example, as shown in column 5 of Jones, predetermined percentages of a progressive jackpot attached to the various card games are calculated (e.g., Five Card Draw Poker, a royal flush nets a player 100% of the progressive jackpot). The disclosure in Jones amounts to nothing more than playing two games at the same time with one hand (e.g., the cards dealt in Twenty-One can be played with the dealer and/or against a pre-determined pay table linked to a progressive jackpot).

Claim 1 recites features including: 1) a primary game; 2) determining a bonus game qualifying event; and 3) obtaining a bonus prize from a plurality of bonuses prizes including an incrementing jackpot and a fixed jackpot. While Jones may recite a primary game and players winning bonus prizes (e.g., progressive jackpots), it fails to disclose techniques for randomly determining a bonus prize from a plurality of bonus prizes after a player first qualifies for the random bonus prize. The determination of winning the progressive jackpot in Jones depends solely on the cards dealt to the player (e.g., a Straight Flush in poker or 5-5-5-5-Ace in 21 entitles the player to receive a predefined portion of the progressive jackpot). In contrast, claim 1 recites features in which, for example, cards dealt to a player provide a qualifying event for entry into playing for a separate bonus prize. Jones discloses no such qualifying event and no such opportunity for playing for a random bonus prize. In Jones, once the cards are dealt, the cards on the table determine the payout from the progressive; the cards do not provide a qualifying event.

Jones also fails to disclose “randomly determining from the gaming prize controller, independent of the primary game outcome, a bonus game outcome for at least one gaming prize from the plurality of gaming prizes,” as found in claim 51. The cards dealt to a player decide the prize obtained; there is no further calculation beyond this initial dealing. The payout percentages as shown, for example, in column 5 of Jones are predetermined card combinations, not random. In contrast, claim 51 recites that the bonus game outcome is “randomly” determined.

Furthermore, as indicated above, claim 1 recites features for calculating odds. Specifically that the “odds of winning the plurality of bonus prizes [are] based at least in part on the odds of winning the primary wagering game and the odds of obtaining the bonus game qualifying event.” Claim 51 recites similar features. As explained above, the odds of winning

disclosed in Jones are directly derived from the cards dealt to the player. Thus, Jones fails to disclose determining odds of winning the plurality of bonus prizes based on (1) the qualifying event, and (2) the primary wagering game.

For at least the above reasons, Applicant respectfully submits that claims 1 and 51 (and their respective dependents) are not anticipated by Jones. Applicant respectfully requests withdrawal of this rejection.

**Claim Rejections – 35 U.S.C. § 103**

Claims 4-8, 53, and 56-60 stand rejected under 35 U.S.C. § 103(a) as allegedly being obvious over Jones in view of Mothwurf (U.S. Patent No. 6,712,695). Applicant respectfully submits that the Declaration under 37 C.F.R. § 1.131 provided on September 30, 2004 and supplemented on February 10, 2006 establishes that the disclosed and claimed subject matter of the instant application was conceived prior to January 16, 2001. Further, the declarations provided show that the inventor worked diligently in attempting to reduce to practice the subject matter of the application up until the filing date of the instant application on June 6, 2001. Prior to January 16, 2001, Applicant documented the claimed subject matter in the form of an invention disclosure document. On October 14, 2000, Applicant sent the invention disclosure to a patent attorney, who began the drafting process of the instant application. Over the next several months, various drafts and reviews of the subject application passed between the patent attorney and the Applicant (*see, e.g.*, Exhibits F, G, and H of Response E filed on February 10, 2006). Additionally, during this time, Applicant met with the patent attorney to discuss the subject matter and the draft application (*e.g.*, on December 8, 2000). Drafts and revisions continued to pass between the patent attorney and Applicant during 2001, until the time of filing of the instant Application on June 6, 2001. Thus, prior to January 16, 2001, Applicant conceived

of the subject matter of the instant application and worked diligently to reduce this conception to practice up until the filing date of the instant Application.

Mothwirth has a filing date of January 16, 2001. Applicant has shown prior conception to January 16, 2001 in combination with diligent reduction to practice. Thus, Mothwirth is not prior art and withdrawal of this rejection is respectfully requested. Of course, it is also noted that both Jones and Mothwirth discuss systems where a prize is awarded/determined by the system. In other words, it is not a user/player determined event that occurs once a prize has been determined, as taught in certain exemplary embodiments of the instant disclosure.

Claims 12, 25, and 26 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Jones in view of Adams (U.S. Publication No. 2001/0003709). Fundamental deficiencies of Jones have been discussed above in connection with claim 1. Adams fails to make up for these deficiencies. Thus, claims 12, 25, and 26 should be allowable at least by virtue of their dependence on claim 1.

### **Conclusion**

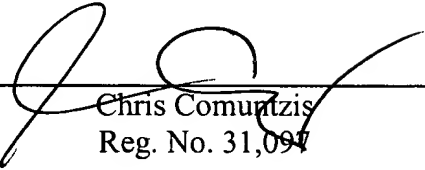
Applicant believes that all of the pending claims clearly and patentably distinguish over the prior art of record and are in condition for allowance. Thus, passage of this case to issuance at an early date is earnestly solicited. Should the Examiner have any questions, or deem that any further issues need to be addressed prior to allowance, the Examiner is invited to call the undersigned attorney at the phone number below.

BRADLEY JOHNSON  
Appl. No. 09/876,546  
September 8, 2009

Respectfully submitted,

**NIXON & VANDERHYE P.C.**

By: \_\_\_\_\_

  
Chris Comuntzis  
Reg. No. 31,097

CC:ac  
901 North Glebe Road, 11th Floor  
Arlington, VA 22203-1808  
Telephone: (703) 816-4000  
Facsimile: (703) 816-4100